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PATENT
03445-P0002A SPM/TMO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of

David Martin

Examiner: Le, Khanh H.

Serial No.: 09/705,671

Group Art Unit: 3622

Filed: November 3, 2000

Confirmation No. 6264

For: Fully Capable Minimally
Inflatable Object Model System
For Multidimensional Applications:

Reply Brief Under 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Appellant hereby replies to the Examiner's Answer mailed December 30, 2005.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: : Mail Stop Appeal Brief – Patents; Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

February 28, 2006


Stephen P. McNamara

In the appeal of *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit reversed a holding of obviousness of claims directed at a method of displaying the functions of a video display device and automatically running a demonstration of how to adjust the functions, to show a user how to make adjustments. The claims were rejected based on reference showing a television set having a menu display, in combination with a video game having a “demonstration mode” showing how to play the game. This was held to be error, because of the lack of any “teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” The Court stated:

“[I]t is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.” *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775(Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. . . . When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008(Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

“The factual inquiry whether to combine references must be thorough and searching.” *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an `essential component of an obviousness holding”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617(Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a

showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637(Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600(Fed. Cir. 1988) (“teachings of references can be combined *only* if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933(Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317(Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.” In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software ” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial ”do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303,

312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

These principles are very much applicable here. The Examiner has rejected independent claims 1, 9, 15 and 19 of the application based on the combination of three magazine articles. The Examiner states that the motivation to combine these references is that *"it would have been obvious to one skilled in the art at the time the invention was made to add Anonymous' method of adjusting contact frequency for a small group and test measured response changes as against a control group to Roseman's prioritized list to determine whether changing call frequencies increase sales as a step toward determining optimum call frequencies....."* (Examiner's Answer at 4).

The Examiner's combination is based on the premise that Anonymous discloses testing promotion response by alteration of call frequency. This assertion reads more into the references than is truly there. Anonymous discloses that an automotive parts supplier increased its sales by 27.9% among the 20,000 customers it had never called on (out of its total of 45,000 account customers) by beginning to make sales calls. The disclosure does not provide any direction on how to design a method of testing promotion response as provided in the detailed discussion of the invention in the specification in a situation where the call frequency and the call content is not controllable to an exact degree.

The Examiner suggests that some of the Appellant's testing methodology may be patentable (Examiner's Answer at 16) but takes the position that the claims as presented are broader than the invention as argued. Applicant respectfully disagrees, and notes that claims are intended to be read in light of the specification and the prosecution history as established by numerous cases. See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)

(“Claims must be read in view of the specification, of which they are a part.”), *aff’d*, 517 U.S. 370 (1996). The patent law permits the patentee to choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning. *Mycogen Plant Science v. Monsanto Co.*, 243 F.3d 1316, 1327 (Fed. Cir. 2001) (“[A] patentee is free to be his own lexicographer, so long as the special definition of a term is made explicit in the patent specification or file history.”). After examining the written description and the drawings, the same confirmatory measure must be taken with the prosecution history, since statements made during the prosecution of a patent may affect the scope of the invention. See *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 862-63 (Fed. Cir. 1991) (affirming the use of prosecution history to construe a claim).

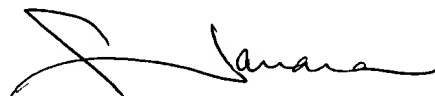
The claims in this application are intended to be interpreted as argued in the Appeal Brief. The Examiner suggests that the claims should include limitations such as “*excluding* telemarketing call centers” (Examiner’s Answer at 17) and “randomizing customers” (Examiner’s Answer at 17) and “representatives with independent biases” (Examiner’s Answer at 15) in order for Appellant’s arguments to be relevant. Appellant respectfully submits that the suggested limitations might help to further define the invention but do not alter what is already claimed in the claims on appeal.

A fair reading of the disclosures of the cited references simply does not disclose or suggest the claimed invention. The Examiner reads far more into the disclosures of Anonymous and Bell than is truly present. Applicant respectfully submits that there is no disclosure, teaching or suggestion of a method of determining effectiveness of direct personal promotion efforts in a marketing environment in which representatives make contact with a customer in accordance with a prioritized list.

Accordingly, for all of the foregoing reasons, the rejection of claims 1-23 should be reversed. It is respectfully submitted that the cited prior art does not disclose or suggest the claimed invention, and that it would not have been obvious to make the claimed invention. It is respectfully requested that the Examiner be directed to issue a Notice of Allowance as to claims 1-23 of the application.

Respectfully submitted,

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